

REMARKS

Summary of the Office Action

Claim 5 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,243,142 to Ishikawa et al.

Claims 5-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ishikawa et al. in view of U.S. Patent No. 6,323,439 to Kambe et al.

Summary of the Response to the Office Action

Applicants have amended claim 5, and respectfully submit that the rejections of claims 5-7 under 35 U.S.C. §§ 102(b) and 103(a) are improper and therefore should be withdrawn. Moreover, Applicants have canceled claims 1-4 and 8-9 without prejudice or disclaimer, and added new claims 10-17. Accordingly, claims 5-7 and 10-17 remain pending in this application for further consideration.

Rejections under 35 U.S.C. §§ 102(b) and 103(a)

Claim 5 stands rejected under 35 U.S.C. §102(b) as being anticipated by Ishikawa et al., and claims 5-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ishikawa et al. in view of Kambe et al. To the extent that these rejections might still apply to the newly amended claim, they are respectfully traversed as being based upon a reference or a combination of references that neither teaches nor suggests the novel combination of features now clearly recited in the claims.

With respect to independent claim 5, as newly-amended, Applicants respectfully submit that Ishikawa et al. does not teach or suggest the claimed combination including at least a feature of “the filling material includes a filler, a thermosetting resin, a curing agent, and a curing catalyst, the thermosetting resin being an epoxy resin, the curing agent being a dicyandiamide curing agent.”

The Office Action alleges that Ishikawa et al. clearly teaches each and every feature of the present invention. Applicants respectfully disagree. In contrast to the present invention of newly-amended independent claim 5, Ishikawa et al. merely discloses a filling material that is a cured product (5) of non-electroconductive resin pate containing a metal powder. Ishikawa et al. fails to teach or suggest a filling material including at least a dicyandiamide curing agent defined in the present invention. In other words, Applicants respectfully submit that Ishikawa et al. fails to disclose the claimed combination including at least the feature of “the filling material includes a filler, a thermosetting resin, a curing agent, and a curing catalyst, the thermosetting resin being an epoxy resin, the curing agent being a dicyandiamide curing agent,” as recited by newly-amended independent claim 5.

In addition, Kambe et al., as described in col. 10, lines 23-24 for example, merely discloses that the filling material is an epoxy resin. Applicants respectfully submit that Kambe et al. cannot remedy the above-noted deficiencies of Ishikawa et al. In other words, Applicants respectfully submit that Ishikawa et al. and Kambe et al., whether taken individually or in combination, do not teach or suggest the claimed combination including at least the feature of “the filling material includes a filler, a thermosetting resin, a curing agent, and a curing catalyst,

the thermosetting resin being an epoxy resin, the curing agent being a dicyandiamide curing agent," as recited by newly-amended independent claim 5.

As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 105 1, 1053 (Fed. Cir. 1987)."

Further, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)."

For at least the reasons as those discussed above, Applicants respectfully assert that the rejections of claim 5 under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because Ishikawa et al. and Kambe et al., whether taken individually or in combination, do not teach or suggest each and every feature of independent claim 5. Furthermore, Applicants respectfully assert that the rejection of dependent claims 6 and 7 should also be withdrawn at least because of their dependencies upon independent claim 5 and for the reasons set forth above.

New Claims 10-17

Applicants have added new claims 10-17 to further define the invention. Applicants respectfully submit that new claims 10-17 are allowable over the prior art of record based on the reasons set forth above and their dependencies upon newly-amended claim 5.

With no other rejections pending, Applicants respectfully assert that claims 5-7 and 10-17 are in condition for allowance.

Conclusion

In view of the foregoing, Applicants respectfully request the reconsideration and the timely allowance of the pending claims. Should the Examiner believe that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS, LLP

By: 

Xiaobin You
Reg. No. L0112

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CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS, LLP
1111 Pennsylvania Avenue, NW
Washington, DC 20004
Tel 202.739.3000
Fax 202.739.3001